



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/991,530  | 11/16/2001  | Shelton Louie        | 1205-011/JRD        | 4257             |
| 21034   | 7590        | 02/23/2005           | EXAMINER            |                  |
| IPSOLON LLP<br>805 SW BROADWAY, #2740<br>PORTLAND, OR 97205 |             |                      | MCCLELLAN, JAMES S  |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |

3627

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/991,530

**Applicant(s)**

LOUIE ET AL.

**Examiner**

James S McClellan

**Art Unit**

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Amendment***

1. Applicant's submittal of an amendment was entered on 11/10/04, wherein:

claims 1-20 are pending and

claims 6 and 13 have been amended.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 6 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6 and 13 require the use of a universally recognized National Drug Code number. However, the National Drug Code is a standard that is subject to change over time, and therefore renders the claim indefinite.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3627

5. Claims 1-8 and 10-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,464,142 (hereinafter "Denenberg") in view of U.S. Patent No. 6,496,806 (hereinafter "Horwitz").

Denenberg discloses a method for taking prescription orders through a retail pharmacy having a plurality of spaced apart locations comprising the steps of receiving the prescription order at a first location upstream of a will call storage area (see column 9, line 64 - column 10, line 4); entering data into a computer system at a second location (16); tagging a carrier of the prescription order with a barcode (see column 6, lines 30-38); manually storing the filled prescription at one of a plurality of storage locations having a plurality of cubbies (14, 18, 20); detecting the prescription order at one of the plurality of storage locations with a barcode reader (see column 8, lines 45-50); recording the location of the prescription order (see column 6, lines 39-47); and displaying the location on a computer display (see column 13, lines 27-47).

Denenberg does not teach a remote tag with a read-writable memory. Horwitz teaches read/write RFID tags used to track items and store item information (see column 8, lines 50 - column 9, line 10).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Denenberg with teachings of Horwitz, because read/write tags that store information further aid in tracking of items.

Neither Denenberg nor Horwitz teach that the identity of the prescribed drug associated with the prescription order is the National Drug Code (NDC) number. However, the National Drug Code number is commonly used in the art, and It would have been obvious to one of

Art Unit: 3627

ordinary skill in the art at the time the invention was made to employ the National Drug Code number to help identify the drug easily.

U.S. Patent No. 5,700,998 (hereinafter "Palti") is cited as factual evidence in support of the Examiner's assertion that the use of NDC numbers is old and well known in the art (see column 2, lines 7-14 and column 5, lines 49-52).

Neither Denenberg nor Horwitz teach the step of activating a transducer on the remote tag to signal a pharmacy worker. However, transducers are common in the art and It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a transducer to signal a pharmacy worker to help locate an item.

U.S. Patent No. 6,249,212 (hereinafter "Beigel") is cited as factual evidence in support of the Examiner's assertion that the use of transducers is old and well in the art of electronic tags (see paragraph bridging columns 2-3).

6. Claims 9 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Denenberg in view of Horwitz as applied to claims 1-8 and 10-19 above, and further in view of U.S. Patent No. 6,611,806 (hereinafter "Harvey").

Denenberg and Horwitz teach all of the limitations of the claims except for a teaching of transmitting a prescription order and filling it at a remote location.

Harvey teaches a tracking system wherein prescriptions are transmitted and filled at remote locations (see column 4, lines 32-34).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Denenberg/Horwitz with teachings of Harvey, because filling orders at a remote location improves efficiency.

*Response to Arguments*

7. Applicant's arguments filed November 10, 2004 have been fully considered but they are not persuasive.

On page 6, fifth and sixth paragraphs, Applicant argues that there is no teaching to use a wireless identification tag with read-writable memory in a retail pharmacy. The Examiner respectfully disagrees. As set forth above Denenberg in combination with Horwitz disclose all the limitations required by claim 1. Denenberg discloses identification tags in a retail pharmacy. Horwitz teaches the use of wireless read/write tags for inventory management. The rejection must be considered as a combination of Denenberg and Horwitz instead of argued individually.

On page 7, third paragraph, Applicant argues that Horwitz is not related to a pharmacy. The Examiner agrees. However, Applicant is once again arguing the references individually. Denenberg, not Horwitz is relied upon for teaching the use of identification tags in a pharmacy. Horwitz is merely relied upon for a specific type of identification tag.

On page 7, final paragraph, Applicant argues that the prior art fails to disclose the features of claim 10 which require a tag reader able to simultaneously detect the presence of a plurality of tags. The Examiner respectfully disagrees. Horwitz teaches the use of tags that communicate with an interrogator (114a, see column 10, lines 4-8).

On page 8, Applicant traverses the Examiner's assertion that transducers are old and well known in the electronic tag art. As set forth above, Beigel is cited as factual evidence to support the Examiner's assertion.

Art Unit: 3627

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim McClellan whose telephone number is (703) 305-0212. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703) 308-5183.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

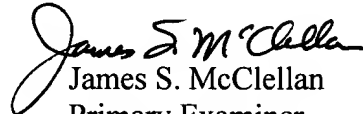
Commissioner of Patent and Trademarks  
Washington D.C. 20231

or faxed to:

Art Unit: 3627

(703) 872-9306 (Official communications) or  
(703) 746-3516 (Informal/Draft communications).

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,  
Arlington, VA, 7<sup>th</sup> floor receptionist.

  
James S. McClellan  
Primary Examiner  
A.U. 3627

jsm  
February 17, 2005